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10/718,058	11/21/2003	James J. Weber	12,554	9292

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William W. Haefliger
Suite 512
201 So. Lake Ave.
Pasadena, CA 91101

EXAMINER

LEWIS, KIANDRA CHARLE

ART UNIT	PAPER NUMBER
3772	

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,058

Applicant(s)

WEBER, JAMES J.

Examiner

Kiandra C. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/21/03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: On page 5 of the specification in the section entitled drawing description the explanation of Fig. 3 recites "is a view like Fig. ?".

On page 7, line 8-9, the application recites "see ring 33 connecting adjustable strap 31 to loop 32." The two do not connect, it is believed that the applicant meant to number adjustable strap as 34.

Appropriate correction is required.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "32" in Fig. 7 has been used to designate a portion of two different adjustable straps and the loop/ring which connects to ring 35. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-15 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-15 of copending Application No. 11/370568. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

As to claims 1 and 3-15 of the instant application, they are identical to claims 1 and 3-15 of the copending application '568.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 2 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 11/370568. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of the instant application is merely a broader recitation of claim 2 of the copending application. Claim 2 of the instant application is anticipated by claim 2 of US Application 11/370568. It would have been obvious to have provided the limitations of claim 2 in view of the structure recited in claim 2 of the US application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1,3-5,7, and 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Padden et al. US 5,569,172.

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As to claim 1, Padden et al. disclose an arm supporting pillow in sling apparatus **Fig. 1** comprising in combination a flexible sling **10**, with a strap to be supported by a user's shoulder area **14** an insert pillow **12** received in the sling, and to be retrievable from the sling, the sling and pillow dimensioned to receive a user's forearm alongside the pillow in the sling **Fig. 7**.

As to claim 3, Padden et al. disclose that the strap **14** has a releasable connection **col. 4, lines 45-49** proximate fore and aft end thereof.

As to claim 4, Padden et al. disclose, that the sling has a releasable drop panel **30** which, when dropped allows the users forearm to dangle downwardly from and below the sling **Fig. 2**.

As to claim 5, Padden et al. disclose that the drop panel **30**, when released, dangles downwardly from a rear portion **31** of the sling while remaining carried by the sling **Fig. 2**.

As to claim 7, Padden et al. disclose, that the sling has forwardly extending panels **30** which are foldable **Fig.1** to be connectible together **30a** along upper extend of the sling, to close the sling over the user's forearm and pillow **Fig. 7**, and to allow upward opening of the sling to release the user's forearm and pillow.

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As to claim 9, Padden et al. disclose that the pillow consists of a foam material **col. 6, lines 1-3**, and has a jacket **60** covering the foam material

As to claim 10, Padden et al. disclose that the pillow may consist of an inflatable container **70**.

As to claim 11, Padden et al. disclose that the combination contains a body strap **24** having opposite ends respectively connected to the sling end to the pillow **22c, 22d**, and having a length to extend about the user's body.

As to claim 12, Padden et al. disclose that the pillow has a releasable connection to the sling **col. 3, lines 10-12**.

As to claim 13, Padden et al. disclose that the pillow has a releasable connection to one of the panels **col. 3, lines 26-30**.

8. Claims 1 are rejected under 35 U.S.C. 102(b) as being anticipated by Burkhead US 5,334,132.

As to claim 1, Burkhead discloses an arm-supporting pillow in sling apparatus **Fig. 2** comprising in combination a flexible sling **10** with a strap **18** to be supported by a user's shoulder area **Fig. 1**, an insert pillow **52** received in the sling and to be retrievable from the sling **col. 3, lines 60-62**.

As to claim 3, Burkhead discloses the strap **18** has releasable connection **col. 3, lines 22-29** to the sling **10** proximate to fore **18A** and aft **18B** ends thereof.

As to claim 4, Burkhead discloses the sling **10** has a releasable drop panel **28** which when dropped allows the user's forearm to dangle **Fig. 3** downwardly from and below the sling **col. 3, lines 30-42**.

As to claim 6, Burkhead discloses a hand holder **46** adjacent to the fore portion of the pillow **Fig.2, col. 3, lines 43-47**.

As to claim 7, Burkhead discloses the sling has forwardly extending panels **22** which are foldable to be connectible together **via 36,38** along the upper extend of the sling, to close the sling over the user's forearm and pillow, and to allow upward opening of the sling to release the user's forearm and the pillow.

As to claim 9 and 10, Burkhead discloses that the pillow **52** consists of a foam material **col. 4, lines 4**, and has a jacket **50** covering the foam material.

As to claim 11, Burkhead discloses that the pillow has a body strap **20** having opposite ends respectively connected to the sling and to the pillow **20a, 20b**, and having length to extend about the user's body.

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As to claim 12, Burkhead discloses that the pillow **52** has releasable connection **54** to the sling **10**.

As to claim 13, Burkhead discloses that the pillow **52** has releasable connection **54** to one of the panels **22a**.

As to claim 14, Burkhead discloses that the sling **10** has a bottom panel adjustable in width to allow sling size adjustment **col. 3, lines 67-68**.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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11. Claim 10 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Burkhead.

As to claim 10, in the event that the applicant is not convinced that the patent expressly discloses the pillows consists of foam rubber or foam plastic it would have been obvious to one having ordinary skill in the art that the foam material **col. 4, line 3** as mentioned by Burkhead could have been either foam rubber or foam plastic, or any other material that would provide a cushioning means for the purpose of comfortably supporting the arm.

As to claim 14, if it is interpreted that all of the limitations are not expressly disclosed in Burkhead as stated in the prior rejection of claim 14, it would have been obvious to one having ordinary skill in the art that if the adjustable means **54** are hook and look the bottom panel could be adjusted in several configurations ranging from very close together to just barely fastened. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to allow the bottom panel to be adjustable for the purpose of modify the size of the sling.

12. Claims 2 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padden et al. and Burkhead.

As to claim 2, Padden et al. and Burkhead disclose all of the limitations of the base claim 1, but do not expressly state that the pillow has a width between 2 ½ and 6 inches. However it would have been obvious to one having ordinary skill in the art at

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the time of the invention to use a pillow with a width between 2 ½ and 6 inches in the invention of Padden et al. for the purpose of providing the user with a pillow sized to fit their comfort need. Furthermore the applicant has not disclosed that such a material provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected the sling of Padden et al. or Burkhead to have performed equally as well with a pillow 1 ½ inches or 7 inches wide. Therefore it would have been obvious to modify Padden et al. or Burkhead to obtain to the invention as specified in claim 2 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art.

As to claim 15, Padden et al. teach the limitations of the base claim 7 as stated above in the 102(b) rejection but does not explicitly state that the adjustable connection of the sling to the side panels allow a limited rotary adjustment of the sling and pillow about a forwardly extending axis. However it would have been obvious to one having ordinary skill in the art at the time of the invention to that any adjustable sling allows for some rotary movement about a forwardly extending axis. Furthermore the applicant has not disclosed that such rotary movement provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art would expect that the sling of Padden et al. could perform equally well with or without limited rotary movement because it would still serve the purpose of securing one's arm within the sling. Therefore it would have been prima facie obvious to modify Padden et al. to

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obtain the invention as specified in claim 15 because it would have been a mere design consideration which fails to patentably distinguish over the prior art.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burkhead in view of Froom US 6,949,077.

As to claim 8 Burkhead discloses all of the limitations of claim 8 but does not expressly disclose that that hand holder **46** comprises a strap. Froom however discloses a hand holder **25** comprising a strap **80** which can be adjustably attached **col. 2, lines 26-29** to the hand holder **46** that may contain a pillow **col. 4, lines 32-34**. Burkhead and Froom are analogous art because they are from the same field of endeavor of supporting an upper body extremity. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Burkhead to contain a strap as disclosed by Froom for the purpose of restraining the hand in a secure position **col. 10, lines 41-44**.

Therefore, it would have been obvious to combine Burkhead with Froom to obtain the invention as specified in claim 8.

Conclusion

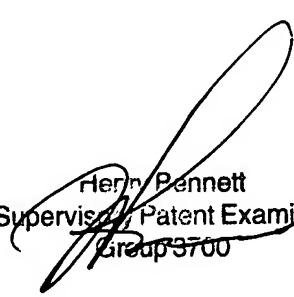
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiandra C. Lewis whose telephone number is 571-272-7517. The examiner can normally be reached on Mon-Thurs 9AM-6PM and alternating Fridays 9AM-5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCL


Henry Bennett
Supervisor, Patent Examiner
Group 3700